



TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

LA SENZA CORP.,

Opposer

vs.

OLYMPIC MOUNTAIN AND MARINE  
PRODUCTS, INC.,

Applicant.

Opposition No. 91185325

77/071,961

**OPPOSER'S BRIEF IN OPPOSITION TO  
APPLICANT'S [SECOND] MOTION FOR LEAVE TO AMEND ANSWER AND  
ASSERT COUNTERCLAIM FOR PARTIAL CANCELLATION**

and

**OPPOSER'S MOTION TO AMEND REGISTRATION**

Opposer, La Senza Corp. ("La Senza"), hereby opposes a second attempt by Olympic Mountain and Marine Products, Inc. ("Olympic") to amend its pleading on the grounds that the proposed pleading is untimely, legally insufficient, procedurally defective, and serves no useful purpose. *See* Section I, *infra*.

Separately, La Senza moves the Trademark Trial and Appeal Board ("Board") to amend Registration No. 1,800,379 for the LA SENZA mark by restricting the identification of goods to that identified in La Senza's renewal application, namely, "body lotions". *See* Section II, *infra*.

Each is discussed in turn.

  
03-22-2010

## Introduction

La Senza brought this opposition proceeding against Olympic's application for registration of the ESSENZA mark on the basis on a likelihood of confusion with La Senza's pleaded LA SENZA trademark registration, and common law rights in the LA SENZA trademark.

Olympic's answer – filed over 1 ½ years ago – did not assert any affirmative defenses or plead any counterclaims (which were compulsory).

Shortly before trial, Olympic moved for summary judgment on *unpleaded* and pleaded issues, and simultaneously moved to amend its answer to assert a compulsory counterclaim (long after the deadline for doing so expired). This motion was rife with procedural and substantive defects. In fact, the filing was so problematic that, even before La Senza's response deadline expired, the Board intervened *sua sponte* to issue an advisory opinion on proper pleading. The Board allowed Olympic additional time to file a "proposed amended answer and counterclaim", which complied with basic pleading requirements.

Olympic filed a proposed amended answer and counterclaim – as one of five (5) exhibits attached to an unauthorized second motion to amend. While Olympic's Second Motion to Amend is unmeritorious and should be denied, *see* Section I, *infra*, La Senza requests that the Trademark Office records be corrected, as set forth in Section II of this filing. It is noted that Olympic never raised this issue with La Senza prior to filing its initial papers with the Board in October of 2009 (had it done so, significant time, money, effort, as well as the Board's limited resources, might not have been needlessly squandered).

### Prosecution History of the LA SENZA Registration

The following prosecution history is relevant to Opposer's Brief in Opposition To Applicant's [Second] Motion for Leave to Amend (Section I), as well as Opposer's Motion to Amend Registration (Section II).

On October 26, 1993, the United States Patent and Trademark Office ("Trademark Office") issued Registration No. 1,800,379 for the LA SENZA mark (the "LA SENZA Registration").

On October 25, 1999, La Senza submitted a "Declaration Under Section 8" (the "Section 8 Declaration") on the LA SENZA Registration, which declared that the LA SENZA mark was in use "in connection with the following goods, namely: **CONDITIONERS AND SKIN MOISTURIZING CREAMS, TOILET SOAPS, BODY, HAND AND FACE LOTIONS AS WELL AS MAKE-UP BAGS SOLD EMPTY**". See Section 8 Declaration, attached hereto as Exhibit A (bold and upper case in original).

In response to the Section 8 Declaration, Trademark Office narrowed the LA SENZA Registration consistent with the Section 8 Declaration. See e.g. March 23, 2000 Notice of Acceptance, attached hereto as Exhibit B.<sup>1</sup>

On October 22, 2003, La Senza submitted a "Combined Declaration of Use in Commerce/Application for Renewal" (the "Combined Declaration") on the LA SENZA Registration, which declared that the LA SENZA mark was in use "on or in connection with the following goods listed in the existing registration, namely: **BODY LOTIONS.**" See Combined

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<sup>1</sup> At some point after registration, "make-up bags sold empty" appears to have been moved from Class 18 to Class 3.

Declaration, attached hereto as Exhibit C (emphasis and upper case in original).

On January 10, 2004, the Trademark Office issued a Notice of Acceptance and Notice of Renewal on the LA SENZA Registration. *See* Exhibit D. However, the Trademark Office did not narrow the LA SENZA Registration consistent with the Combined Declaration. Both parties assert that it was error for the Trademark Office to not narrow the goods of the LA SENZA Registration to those listed in the Combined Declaration, namely, “body lotions”.<sup>2</sup>

Without appreciating the Trademark Office error, and relying on the public records of the Trademark Office, La Senza’s Notice of Opposition was prepared and filed on July 21, 2008, in which registration of Olympic’s ESSENZA application was opposed on the grounds of a likelihood of confusion with La Senza’s LA SENZA mark, including the LA SENZA Registration. Printouts of information from the electronic database records of the Trademark Office were attached to the Notice of Opposition, as Exhibit 1. *See* Notice of Opposition, ¶3 and Exhibit 1. As noted above, these printouts contained an error.

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<sup>2</sup> *See e.g.*, First Motion to Amend, p.7 (Olympic “does not allege that La Senza misrepresented its use of the LA SENZA mark to the Trademark Office ....”) (parenthetical omitted) .

## **I. OLYMPIC'S SECOND MOTION TO AMEND SHOULD BE DENIED.**

Olympic's Proposed Amended Answer is untimely, legally insufficient, procedurally defective, and serves no useful purpose. Accordingly, La Senza respectfully submits that Second Motion to Amend should be denied with prejudice.

### **A. Relevant Procedural Background**

On July 21, 2008, La Senza filed its Notice of Opposition.

On August 28, 2008, Olympic filed its Answer to the Notice of Opposition. The Answer did not plead any affirmative defenses or counterclaims (which were compulsory).

On October 1, 2009 – more than one year after it filed its Answer and with the trial fast approaching – Olympic made its first (unsuccessful) attempt to amend its pleadings by seeking to add compulsory counterclaims and affirmative defenses. Specifically, Olympic filed its first Motion to amend, within the joint filing entitled “Applicant’s Motion for Leave to Amend and for Summary Judgment” (the “First Motion to Amend”), which attached a memorandum of law and a declaration with numerous associated exhibits. Olympic failed to proffer any reason for the delinquency of the First Motion to Amend.

On November 5, 2009, the Board took the unusual step of issuing, *sua sponte*, an advisory opinion concerning the First Motion to Amend. Essentially, the Board denied the First Motion to Amend on a number of procedural and substantive grounds, especially as it related to Olympic's fraud claim, which was pleaded over a month *after* the issuance of *In re Bose Corp.*<sup>3</sup> After outlining the various procedural and pleading defects in the First Motion to Amend, the

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<sup>3</sup> On August 31, 2009, the United States Court of Appeals for the Federal Circuit issued *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

Board allowed Olympic time to “file the appropriate filing fee<sup>4</sup> and a copy of the proposed amended answer and counterclaim, failing which the motion for leave to amend shall stand denied.” November 5 Order, p.4 (emphasis supplied).

Conceding the deficiencies in its earlier filing, Olympic did not pursue its request for leave to plead a fraud claim. Rather, Olympic filed “Applicant’s [Second] Motion for Leave to Amend Answer and Assert Counterclaim for Partial Cancellation” (the “Second Motion to Amend”).<sup>5</sup> The Second Motion to Amend attached a proposed pleading, namely, “Applicant’s Amended Answer to Notice of Opposition and Counterclaim for Cancellation” (the “Proposed Amended Answer”).

In short, Olympic’s First Motion to Amend was factually and legally baseless, and procedurally defective. Olympic’s second effort is equally without merit, and should be denied, as well.

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<sup>4</sup> Presumably, the appropriate fee was paid by Olympic, but La Senza has no way of verifying same.

<sup>5</sup> Since Olympic was only authorized to file “the proposed amended answer and counterclaim”, and *not* another substantive brief with numerous exhibits, the Second Motion to Amend is well beyond the scope of the November 5 Order, and may be stricken by the Board.

## **B. Argument**

### **1. Olympic's Second Motion to Amend Is Untimely and Should Be Dismissed.**

The Second Motion to Amend seeks to amend Olympic's Answer to add a counterclaim and affirmative defenses.

#### **a. Olympic's Delinquent Attempt to Add a Compulsory Counterclaim Should Be Denied.**

Olympic's asserts that the proper "standard of review" for its request is governed solely by Fed. R. Civ. P. 15(a)(2) ("The court should freely give leave when justice so requires"); and Trademark Rule §2.107(a). Olympic is wrong. "Counterclaims to cancel pleaded registrations in Board proceedings are governed by 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i)." *See* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §507.02(b) ("Timing of Motion to Amend to Add Counterclaim").

A claim to cancel [in whole or in part] a registration which has been pleaded by the opposer in a Notice of Opposition "shall" be a compulsory counterclaim, which must be filed with, or as part of, the Answer to the Notice of Opposition, if the grounds for the counterclaim exist at the time when the answer is filed; otherwise, the counterclaim shall be pleaded promptly after the grounds therefor are learned. 37 C.F.R. 2.106(b)(2)(i); *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986). *See also Vitaline Corp. v. General Mills*, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989); TBMP §313.04.

Olympic's proposed counterclaims for partial cancellation are based on events purported to have occurred over six (6) years ago, and at the time the Notice of Opposition was filed. Moreover, the records memorializing these events are public records which were readily available to Olympic prior to the filing of its Answer over 1 ½ years ago. Patently, this ground

existed at the time Olympic filed its Answer. Since Olympic did not raise its compulsory counterclaim in its Answer, it cannot do so now, over one year later.

Indeed, Olympic's Second Motion to Amend ignored *completely* the compulsory nature of its delinquent counterclaim. Accordingly, it cannot now be heard to argue that it is somehow timely or satisfies the requirements of the Trademark Rules.

b. Olympic's Long and Unexplained Delay in Raising Its Affirmative Defense Requires Denial of the Second Motion to Amend.

When justice so requires, the Board will grant leave to amend pleadings to add affirmative defenses, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party. TBMP §507.02. The "timing of a motion for leave to amend under FRCP 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely." TBMP §507.02(b) (emphasis supplied). In this case, Olympic did not attempt to amend its pleadings until over one year after it filed its Answer. Moreover, Olympic did not even bother to proffer an explanation for its long delay. Accordingly, the Motion should be denied. *Id.*, See *International Finance Corporation v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001) (motion to amend opposition denied where it was filed eight months after filing of notice of opposition, with no explanation for the delay, and appeared to be based on facts within opposer's knowledge at the time opposition was filed);

*Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982) (opposer's motion to amend to rely on eight additional marks, shortly after the close of the discovery period, denied where opposer knew, or should have known, of the existence of the marks at the time the opposition was filed). Accordingly, Olympic's delinquent motion to plead an affirmative defense should be denied.

## **2. Olympic's Amended Pleading Is Legally Insufficient and Leave Should Be Denied**

It is axiomatic that "where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend." *See* TBMP §507.02. Olympic's proposed amended pleadings are legally insufficient and would serve no useful purpose. Accordingly, it is respectfully submitted that Applicant's Second Motion to Amend should be denied.<sup>6</sup>

### **A. Olympic's Abandonment Counterclaim is Legally Insufficient**

Abandonment of a trademark occurs . . . "[w]hen its use has been discontinued with intent not to resume such use." 15 U.S.C. §1127. Such intent may be inferred from circumstances, with "nonuse for 3 consecutive years shall be prima facie evidence of abandonment." *Id.*

Olympic's Proposed Amended Answer *appears* to allege abandonment of the LA SENZA mark as a ground for cancellation of the LA SENZA Registration. However, there is no allegation regarding the constituent elements of an abandonment claim (*e.g.*, discontinued use,

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<sup>6</sup> While La Senza respectfully submits that Olympic's Second Motion to Amend should be denied, La Senza does not contend that the error in the LA SENZA Registration should remain uncorrected. Rather, in a later section of this filing, La Senza requests that the Board amend the LA SENZA Registration by deleting all goods in the identification of goods, other than "body lotions". See Section II La Senza's Motion to Amend Registration, *infra*.

intent to not resume, length of alleged non-use). Since Olympic failed to plead the elements of even *prima facie* abandonment, this claim should be dismissed.

B. Since Trademark Office Errors Do Not Constitute Valid Grounds for Cancellation, Olympic's Second Motion to Amend Should Be Denied.

As noted above, Olympic's compulsory counterclaim is grossly delinquent, and the Second Motion to Amend should be denied on this ground. Moreover, the underlying claim (Trademark Office error) fails to raise a statutory ground for the requested cancellation, and the Second Motion to Amend may be denied on this ground, as well.

A "petition to cancel registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged . . . by the registration of a mark on the principal register . . .". 15 U.S.C. § 1064. A petitioner must establish, *inter alia*, a "valid ground why the registrant is not entitled under law to maintain the registration." *Young v. AGB Corp.*, 47 USPQ2d 1752 (CAFC 1998), *citing Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ 185, 187 (CCPA 1982). The "'valid ground' that must be alleged and ultimately proved by a cancellation petitioner must be a 'statutory ground which negates the appellant's right to the subject registration.'" *Young, supra*, *citing Lipton*, 213 USPQ at 190 (emphasis supplied).

However, Olympic's counterclaim alleging errors by the Trademark Office does not constitute a "valid" ground for a cancellation action. *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057 (TTAB 2000) (motion to amend denied because examiner's failure to enforce submission of foreign registration was examination error); *Saint-Gobain Abrasives, Inc. v. Unova Ind. Auto. Sys., Inc.*, 66 U.S.P.Q.2d 1355 (TTAB 2003) (fairness dictates that the *ex parte*

questions not be a ground for cancellation). Accordingly, Olympic's Second Motion to Amend should be denied.

C. Olympic's Proposed Affirmative Defense of Unclean Hands Is Legally Insufficient

A "trademark plaintiff has 'unclean hands' when its conduct relative to its mark has been *illegal or otherwise unconscionable*." See 3 GILSON ON TRADEMARKS §11.08 (emphasis supplied); *Citizens Financial Group Inc. v. Citizens National Bank of Evans City*, 72 USPQ2d 1389 (3d Cir. 2004) ("courts require clear, convincing evidence of 'egregious' misconduct before invoking the doctrine of unclean hands") (emphasis supplied).

Moreover, the actor's intent is critical:

In order for a defendant to establish the defense of unclean hands, it must demonstrate that the plaintiff's conduct was *intentionally* illegal or unconscionable. Inadvertent or careless misstatements do not constitute unclean hands, nor do false statements that were apparently made in good faith.

GILSON, *supra*. (emphasis supplied).

Olympic's Proposed Amended Answer does not allege facts which can establish the defense of "unclean hands". Specifically, Olympic's allegation – that La Senza's technical non-compliance with regulations "fostered, if not caused" the Trademark Office to erroneously renew the LA SENZA Registration for more goods than identified in the Combined Declaration – does not constitute intentionally illegal or unconscionable conduct, as discussed below.<sup>7</sup> Accordingly, the Second Motion to Amend should be denied.

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<sup>7</sup> Applicant's Second Motion to Amend raises another ground, namely, that "steps were not taken" to ensure there were no inadvertent errors in the LA SENZA registration. However, this allegation is not present in the proposed Amended Answer, and so need not be considered by the Board. In any event, this allegation, by its own terms, does not rise to the level of intentionally illegal or unconscionable conduct.

i. Trademark Rule 2.161(f)(2) Is Irrelevant to Unclean Hands Defense.

The Proposed Amended Answer alleges that the failure of La Senza to comply with Trademark Rule 2.161(f)(2) “fostered, if not caused” the Trademark Office to erroneously maintain the LA SENZA Registration for more goods than identified in the Combined Declaration. However, the noted rule is completely irrelevant since it is applicable to declarations seeking to establish that “nonuse is due to special circumstances which excuse such nonuse”, 15 U.S.C. §1058(b)(2), as indicated by the very text of the cited Rule:

A complete affidavit or declaration under section 8 of the Act must:

...

(f) ...

(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume; and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark[.]

37 C.F.R. §2.161(f)(2) (emphasis supplied); *see also*, TMEP §1604.11. Since La Senza did not seek to maintain the registration on the basis of excusable nonuse, this rule is wholly irrelevant to La Senza’s filing. Accordingly, the allegation that La Senza “failed” to comply with an irrelevant rule is, itself, irrelevant.

ii. Alleged Non-Compliance with Trademark Rule 2.161(e)(2) Does Not  
Constitute Unclean Hands.

Olympic acknowledges that the La Senza made no misrepresentation to the Trademark Office, and that the Trademark Office erroneously renewed the the LA SENZA Registration for more goods than identified in the Combined Declaration. Rather, Olympic claims, on information and belief, that by not listing the goods to be deleted from the registration in the Combined Declaration, La Senza “fostered, if not caused” the Trademark Office error. This speculative and unprovable allegation does not constitute unclean hands.

La Senza respectfully submits that the conduct complained of comprises a “minor technical defect” regarding a Trademark Rule (not a statute) that is a mere “formality”, designed for administrative convenience. *In re Mother Tucker’s Food Experience (Canada), Inc.*, 17 USPQ2d 1795 (CAFC 1991); *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 160 USPQ 715, 720 (CCPA 1969) (inadvertently including specimen with minor differences “mere technical defect”).

As the Federal Circuit has noted:

There is a compelling difference between noncompliance with a statutory requirement and a mere technical defect. While the latter may often be remedied with discretionary benevolence, the former is another matter.

*In re Mother Tucker’s Food, supra* at 1797.<sup>8</sup> Since La Senza’s Combined Declaration provided truthful information – a contention Olympic does not contest – but in a form different from that called for by the Rules, La Senza respectfully submits that invocation of the equitable doctrine of

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<sup>8</sup> Olympic does not allege non-compliance with a statute, but rather an administrative rule. “Administrative discretion may enable correction of a technical defect *nunc pro tunc*, but failure to comply with a statutory provision offers far less flexibility to the administrator and the courts.” *In re Mother Tucker’s Food, supra*.

unclean hands is not appropriate.

Furthermore, Olympic speculates that if La Senza complied with the Trademark Rules, “it would have been apparent that goods and classes were being dropped from the registration”, and the Trademark Office would not have erred. Second Motion to Amend, p.5. As an initial matter, this is a speculative claim that cannot be proven. Moreover, La Senza respectfully submits that the Combined Declaration starkly set apart the identified goods from the rest of the text of the Combined Declaration such that it should “have been apparent that goods and classes were being dropped from the registration”. The identified goods “**BODY LOTIONS**” were rendered in bold typeface and in upper case letters, in contrast to the remaining text in the same paragraph as the identified goods. Thus, it should “have been apparent” from the Combined Declaration “that goods and classes were being dropped from the registration”, such that “failure of strict compliance” with the formality of Rule 2.161(e)(2) does not trigger the doctrine of unclean hands.<sup>9</sup>

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<sup>9</sup> Indeed, La Senza *essentially* (though, perhaps, not strictly) complied with the Rule, if in reverse: rather than listing the goods to be deleted from the LA SENZA Registration, the Combined Declaration listed the goods to be maintained. In fact, La Senza adopted this very same approach in filing the Section 8 Declaration; and the Trademark Office properly narrowed the LA SENZA Registration.

iii. La Senza's Reliance on Trademark Office Records  
Does Not Constitute Unclean Hands

As noted above, the Proposed Amended Answer did not include any allegations regarding La Senza's alleged failure to "take steps" to ensure that there were no errors in the prosecution history of the LA SENZA Registration before pleading that registration in the Notice of Opposition. Moreover, the Second Motion to Amend is not properly before the Board in view of the terms of the Board's Order. Accordingly, this allegation is not properly before the Board. However, *under protest and without conceding that the claim is properly before the Board*, La Senza addresses this issue since it was raised (only) in the Second Motion to Amend.

Olympic's Second Motion to Amend alleges that [unspecified] "steps were not taken" to ensure that the LA SENZA Registration "was in full force as to the goods listed in the registration before asserting the registration in an opposition proceeding." Second Motion to Amend, pp.6-7.<sup>10</sup> As an initial matter, this vague, non-specific allegation runs afoul of Fed. R. Civ. P. 9(b), a rule cited to Olympic in the Board's Order. Specifically, the rule requires that "[i]n all averments of fraud or *mistake*, the circumstances constituting fraud or *mistake* shall be stated with particularity." *Id.* (emphasis supplied). Olympic's vague "steps were not taken" allegation fails to meet the appropriate pleading requirements. Accordingly, Olympic's Second Motion to Amend should be denied.

However, even if Olympic's non-specific allegation were properly before the Board and pleaded with sufficient particularity, the alleged conduct certainly does not rise to the level of

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<sup>10</sup> Presumably, this allegation covers all possible errors that might have arisen at any time during the preparation, execution, filing, prosecution, maintenance of, and/or chain of title to, the LA SENZA Registration over the nearly twenty (20) years since the application was filed.

“intentionally illegal or unconscionable” conduct necessary to trigger the doctrine of unclean hands.<sup>11</sup>

The sole case cited by Olympic is inapposite, and readily distinguishable from the case *sub judice*, as one essentially sounding in fraud — but cast as an unclean hands case because the movant believed that the fraud was unavailable to it. In fact, the Second Motion to Amend mischaracterizes the *Duffy-Mott* case:

Significantly, in *Duffy-Mott Company*, the court was not addressing conduct that could be characterized as purposefully fraudulent or manipulative, but rather the opposer’s carelessness in not making sure the registration it was renewing was still in force as to all of the goods listed in the registration.

Second Motion to Amend, p.6 (emphasis supplied). Both assertions are wrong.

In *Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 165 USPQ 422 (CCPA 1970), the Court found that the opposer’s predecessor-in-interest filed a “patently false combined affidavit” in order to maintain the registration. Indeed, during the proceeding, the General Manager of the relevant division at opposer’s predecessor testified that the company had never used the mark for many of the goods listed in the combined affidavit. The movant would have moved for cancellation on grounds of fraud, but believed that such relief was not available to it.<sup>12</sup> Thus, the

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<sup>11</sup> Moreover, La Senza’s reliance on erroneous PTO records to craft its Notice of Opposition does not constitute “unclean hands”. GILSON ON TRADEMARKS, *supra*. (“[i]nadvertent or careless misstatements do not constitute unclean hands, nor do false statements that were apparently made in good faith.”), *Wilson Jones Co. v. Gilbert & Bennett Mfg. Co.*, 141 USPQ 620 (2<sup>nd</sup> Cir. 1964) (court found that the appellant’s misrepresentations in the complaint concerning actions in opposition proceeding did not rise to level of unclean hands).

<sup>12</sup> *Duffy-Mott, Co., Inc., supra*, at 425 (“Applicant says it is not attacking the validity of the registration arguing, in fact, that under section 14 of the statute (15 U.S.C. 1064) there is no ground on which it could possibly apply here, the false statements in the affidavit were not for the purpose of *obtaining* the registration. Applicant, therefore, asks that opposer be precluded from relying, in this proceeding, on a registration which he felt could not be attacked by a petition to cancel”)(italics in

movant sought relief under the equitable doctrine of unclean hands. In short, the *Duffy-Mott* Court applied the equitable doctrine of unclean hands to address what was essentially fraudulent conduct.

Additionally, while the opposer in *Duffy-Mott* unsuccessfully sought to construe the filing of a “patently false combined affidavit” as “*carelessness*”, the Court was not persuaded: “This can scarcely be characterized as mere carelessness or misunderstanding to be winked at as of no importance.” *Duffy-Mott, Co., Inc., supra*, at 425 (emphasis supplied). Thus, Olympic’s (mis)characterization of *Duffy-Mott* contrasts sharply with the terms of the decision.<sup>13</sup> In any event, La Senza respectfully submits that the facts in *Duffy-Mott* are far different than those alleged in the Second Motion to Amend.

Finally, “the extent of actual harm caused by the conduct in question” is a highly relevant consideration in determining whether to invoke the equitable doctrine of unclean hands. *Citizens Financial Group, Inc., supra*. Opposer respectfully submits that the erroneously included goods in the LA SENZA Registration (and repeated in the Notice of Opposition), namely, conditioners

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original, underscore supplied).

<sup>13</sup> It also contrasts with the treatment by other courts and learned scholars. *See e.g., Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1444 (9th Cir. Cal. 1990) (“Any false statements made in an incontestability affidavit may jeopardize not only the incontestability claim, but also the underlying registration.”); *Jimlar Corp. v. Montrexpert S.P.A.*, Cancellation No. 92032471 2004 TTAB LEXIS 333 (TTAB June 4, 2004) (“The intent element of fraud may be found when an applicant or registrant makes a false, material representation that the applicant or registrant knew or should have known was false.”) (unpublished); 15 USCS § 1063, n. 50 (“Applicant can, by way of affirmative defense in its answer to opposition, raise issue of fraud in obtaining and maintaining opposer’s registration; in procurement of trademark registration, false affidavit stating that mark appeared on goods which did not in fact bear mark was sufficiently fraudulent to sustain defense of unclean hands in opposition proceeding.”); 3 *Gilson on Trademarks* §4.11 (and n.5-6), 11.07 (and n.116-7), and §11.08 (and n. 32-33) (“In the Patent and Trademark Office, fraud may be asserted to block an opposer’s reliance on a fraudulently obtained registration and may also form the basis for an opposition or a counterclaim or petition to cancel a registration”).

and skin moisturizing creams; toilet soaps; hand and face lotions, as well make-up bags sold empty are not so dissimilar from “body lotions” that their inclusion would have had any material impact on the likelihood of confusion analysis. Accordingly, the allegation does not support invocation of the unclean hands doctrine.

### **3. Miscellaneous Errors in Olympic’s Second Motion to Amend**

As recounted above, Olympic’s original filing contained various procedural defects (seeking judgment on unpleaded claims, failing to submit the filing fee, *etc.*). Olympic’s Second Motion to Amend also contains procedural defects and irregularities. For example, the Board’s Order only authorized Olympic to file “the proposed amended answer and counterclaim”. Order, p. 4. However, not only did Olympic submit the Proposed Amended Answer, it also submitted an additional brief containing four (4) other exhibits. Accordingly, Olympic’s Second Motion to Amend is well beyond the scope of the Board’s Order, and may be stricken by the Board.

Additionally, Olympic failed to submit a **signed** copy of the Proposed Amended Answer. *See* TBMP §507.01 (“A **signed** copy of the proposed amended pleading should accompany a motion for leave to amend a pleading.”) (emphasis supplied).

Finally, Olympic improperly seeks to amend its answer to the Notice of Opposition on an issue unrelated to, and *not disclosed to the Board or La Senza* in, the Second Motion to Amend. Specifically – without Board authorization – Olympic seeks to amend its answer to paragraph 8 of the Notice of Opposition. *See* Proposed Amended Answer, ¶8 (from a conditional denial to a general denial). Since such a proposed amendment was not within the scope of the Board’s Order (and was not disclosed by Olympic), it should be denied.

**Conclusion**

In view of the various legal and procedural deficiencies in the Proposed Amended Answer (and Second Motion to Amend), outlined above, and La Senza's Motion to Amend Registration, set forth below (*see* Section II, *infra*), La Senza respectfully submits that Olympic's Second Motion to Amend should therefore be denied, and the Proposed Amended Answer refused.

Again, had Olympic simply raised this issue with La Senza – instead of filing facially defective Motions to amend – La Senza, and/or the parties jointly, could have moved to correct the registration, *see* TBMP §514.03, and significant time, resources and effort would have been saved.

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## II. LA SENZA'S MOTION TO AMEND REGISTRATION

COMES NOW La Senza and, pursuant to 15 U.S.C. §1057(g), 37 C.F.R. §2.133, and TBMP §514 and consistent with La Senza's Combined Declaration, respectfully requests the Board to amend the LA SENZA Registration by deleting all goods in the identification of goods, other than "body lotions". La Senza incorporates, by reference, Section I of this filing, as if fully set forth herein.

The Board has the authority to amend a registration that is pleaded in, and during the pendency of, an *inter partes* proceeding. 37 C.F.R. §2.133, and TBMP §514; *see also In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).<sup>14</sup>

As set forth above, La Senza respectfully submits that the Trademark Office inadvertently erred in not deleting certain goods from the LA SENZA Registration following the submission of the Combined Declaration, and that amendment of the registration is warranted. Moreover, the requested amendment is proper in that it is clearly limiting in nature. 37 C.F.R. §2.71(a).

Furthermore, in view of the above, La Senza respectfully requests that, after the LA SENZA Registration is amended, La Senza's Notice of Opposition and Olympic's (unamended) Answer be construed to reflect the amendment.

In sum, while Olympic's Second Motion to Amend is without merit, La Senza requests that the Trademark Office's error be corrected, and the pleadings construed to reflect the correction.

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<sup>14</sup> La Senza did not file a Section 7(g) request with the Trademark Office since the registration is the subject of an *inter partes* proceeding. 37 C.F.R. §2.133; TBMP §514

Respectfully submitted,

LA SENZA CORP.

By:

  
\_\_\_\_\_  
George W. Lewis  
Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
(202) 638-6666

March 22, 2010

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on this 22<sup>nd</sup> day of March, 2010, a true copy of the foregoing OPPOSER'S BRIEF IN OPPOSITION TO APPLICANT'S [SECOND] MOTION FOR LEAVE TO AMEND ANSWER AND ASSERT COUNTERCLAIM FOR PARTIAL CANCELLATION and OPPOSER'S MOTION TO AMEND REGISTRATION was served by first-class mail, postage prepaid, upon counsel for Applicant:

Philip A. Kantor, Esquire  
Law Offices of Philip A. Kantor, P.C.  
1781 Village Center Circle, Suite 120  
Las Vegas, NV 89134





PRU

10-25-1999

U.S. Patent & TMO/™ Mail RptDt. #11

TRADEMARK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: **LA SENZA**

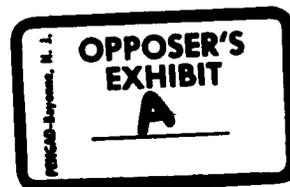
Registration No.: **1,800,379**

Issued: **October 26, 1993**

**DECLARATION UNDER SECTION 8**

**IRVING TEITELBAUM** declares that he is the Chairman of the Board of **LA SENZA INC.**, and authorized to make this declaration as an officer of and on behalf of said corporation, a corporation duly organized and existing under the laws of Canada, located at 1370 Dundas Street East, Suite 210, Mississauga, Ontario, Canada, L4Y 4G4; that the said corporation is the owner of Registration no. 1,800,379 issued October 26, 1993, as evidenced by the Patent and Trademark Office records; that the mark shown therein is currently in use by the Registrant, in foreign commerce between Canada and the United States and/or in interstate commerce in the United States, in connection with the following goods, namely: **CONDITIONERS AND SKIN MOISTURIZING CREAMS, TOILET SOAPS, BODY, HAND AND FACE LOTIONS AS WELL AS MAKE-UP BAGS SOLD EMPTY**; that the mark is still in use in such commerce as evidenced by the attached specimen(s) showing the mark as now in use in connection with the above identified goods; that there has been no final decision adverse to Registrant's claim of ownership of such mark for such goods or its right to register the same or maintain the same on the Register; that there is no proceeding involving any of said rights pending in the Patent and Trademark Office or in a Court; and not finally disposed of; that all statements made herein of his own knowledge are true and all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false

#309668.01



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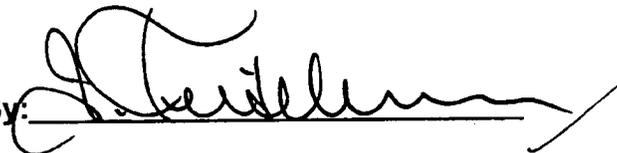
01 FC:372

statements may jeopardize the validity of this declaration and the registration to which it relates.

The law firm of JACOBSON, PRICE, HOLMAN & STERN, PLLC., whose postal address is 400 Seventh Street, N.W., Washington, D.C. 20004-2201, is hereby designated Applicant's Domestic Representative upon whom notices or process in proceedings affecting the mark may be served.

Registrant hereby appoints **SIMOR L. MOSKOWITZ**, HARVEY B. JACOBSON, JR., D. DOUGLAS PRICE, JOHN CLARKE HOLMAN, MARVIN R. STERN, MICHAEL R. SLOBASKY, MARSHA G. GENTNER, JONATHAN L. SCHERER, IRWIN M. AISENBERG, WILLIAM E. PLAYER and YOON S. HAM, its attorneys, to file this declaration and to transact all business in the Patent and Trademark Office in connection therewith. Please address all correspondence to JACOBSON, PRICE, HOLMAN & STERN, PLLC., 400 Seventh Street, N.W., Washington, DC 20004.

**LA SENZA INC.**

By: 

**Printed Name: Irving Teitelbaum**

**Title: Chairman of the Board**

Date: October 20, 1999 ✓

Attorney Docket No.: 1432/T-13183

Lori O.

DIS 4/6



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

T13183

REGISTRATION NO: 1800379 SERIAL NO: 74/121287 MAILING DATE: 03/23/2000  
REGISTRATION DATE: 10/26/1993  
MARK: LA SENZA  
REGISTRATION OWNER: LA SENZA INC.  
CORRESPONDENCE ADDRESS:

SIMOR L. MOSKOWITZ  
JACOBSON, PRICE, HOLMAN & STERN  
400 SEVENTH STREET, N.W.  
WASHINGTON, DC 20004-2201

### NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(1)

THE AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

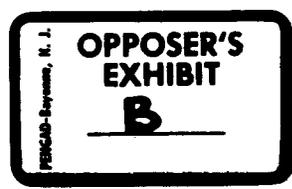
ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

\*\*\*\*\*

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):  
003 018.

WEAVER, TIFFANY  
PARALEGAL SPECIALIST  
POST-REGISTRATION DIVISION  
(703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION



## REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION

### I) SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

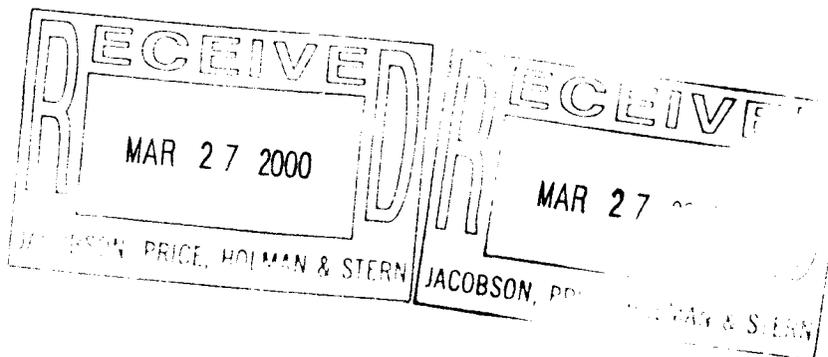
**Failure to file the Section 8 Affidavit will result in the cancellation of the registration.**

### II) SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

**Failure to file the Application for Renewal will result in the expiration of the registration.**

**NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.**



TRADEMARKS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Registration of:

La Senza Inc.

Registration No.: 1,800,379

Registered: October 26, 1993

Mark: LA SENZA

COMBINED DECLARATION OF USE IN COMMERCE/APPLICATION  
FOR RENEWAL

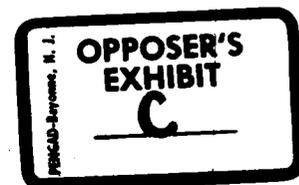
La Senza Inc. is a corporation duly organized and existing under the laws of Canada, located and doing business at 1370 Dundas Street East, Suite 210, Mississauga, Ontario, Canada L4Y 4G4.

The owner is using the above-identified mark in commerce on or in connection with the following goods listed in the existing registration, namely: **BODY LOTIONS**.

The owner is using the mark in commerce on or in connection with the goods identified above, as evidenced by the attached specimen(s) showing the mark as currently used in commerce.

The registrant requests that the registration be renewed for the goods identified in the registration.

The law firm of JACOBSON HOLMAN PLLC, whose postal address is 400 Seventh Street, N.W., Washington, D.C. 20004-2201, is hereby designated Applicant's Domestic Representative upon whom notices or process in proceedings affecting the mark may be served.



Please recognize SIMOR L. MOSKOWITZ, HARVEY B. JACOBSON, JR., JOHN CLARKE HOLMAN, MARVIN R. STERN, ALLEN S. MELSER, MICHAEL R. SLOBASKY, MARSHA G. GENTNER, JONATHAN L. SCHERER, IRWIN M. AISENBERG, GEORGE W. LEWIS, WILLIAM E. PLAYER, YOON S. HAM and NATHANIEL A. HUMPHRIES as the attorneys representing the above-identified Applicant in all matters associated with the above-identified registration. Please address all correspondence to CUSTOMER NO. 00136 or the law firm of JACOBSON HOLMAN PLLC, The Jenifer Building, 400 Seventh Street, N.W., Washington, D.C. 20004-2201.

The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

LA SENZA INC.

By: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Date: October 16, 2003  
Attorney Docket No.: T-13183

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514  
www.uspto.gov

REGISTRATION NO: 1800379 SERIAL NO: 74/121287 MAILING DATE: 01/10/2004  
REGISTRATION DATE: 10/26/1993  
MARK: LA SENZA  
REGISTRATION OWNER: LA SENZA INC.

**CORRESPONDENCE ADDRESS:**

SIMOR L. MOSKOWITZ  
JACOBSON, HOLMAN PLLC  
THE JENIFER BUILDING  
400 SEVENTH STREET, N.W.  
WASHINGTON, D.C. 200042201

**NOTICE OF ACCEPTANCE**

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058. ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

\*\*\*\*\*

**NOTICE OF RENEWAL**

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059. ACCORDINGLY, THE REGISTRATION IS RENEWED.

\*\*\*\*\*

**THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):**  
003, 018.

WEST, JOYCE M  
PARALEGAL SPECIALIST  
POST-REGISTRATION DIVISION  
(703)308-9500

**PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION  
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION  
ORIGINAL**

**REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION) SECTION 8: AFFIDAVIT OF CONTINUED USE** The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration. **Failure to file the Section 8 Affidavit will result in the cancellation of the registration.**  
**II) SECTION 9: APPLICATION FOR RENEWAL** The registration shall remain in force for 10 years, subject to the provisions of Section 8,



except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration. **Failure to file the Application for Renewal will result in the expiration of the registration.**

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